



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/115,229	07/14/98	SCHEELEN	A SLVAY-3741.0

IM22/0901

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EXAMINER

NOLD, C

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 09/01/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

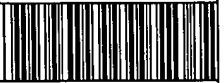
Office Action Summary

Application No.
09/115,229

Applicant(s)
Scheelen et al

Examiner
Charles R. Nold

Group Art Unit
1772



☒ Responsive to communication(s) filed on paper no. 7, 6/18/99

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-15 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-15 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit:

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 4/8/99 fails to comply with 37 CFR 1.97(c) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered.
2. The information disclosure statement filed 4/8/99 fails to comply with 37 CFR 1.97(c) because it lacks the fee set forth in 37 CFR 1.17(p). It has been placed in the application file, but the information referred to therein has not been considered.

The examiner note applicants arguments submitted with the IDS. The issue is whether english language counter parts to non-english references (submitted with no translation or explanation of relevance), when submitted after first action without certification or fee are to be considered. The examiner can find no specific support in applicants cited passages (1338 OG 39 ff) that this IDS should be considered.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. The rejection of claims 8-9 under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter is withdrawn due to applicants' amendments.

Art Unit:

5. *Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 5 are rejected under 35 U.S.C. 102(b) as being anticipated by

US 5,049,441 Jenkins et al. Jenkins et al discloses HDPE compositions containing HDPE and talc, said talc in an amount of about 1 percent, col. 2, line 38. The size of the talc is .5 to 50 microns.

Response to Arguments

8. Applicant's arguments filed 6-18-99 have been fully considered but they are not persuasive.

Applicant argues that Jenkins et al does not disclose applicants claimed amount of talc. The examiner respectfully disagrees. Jenkins' disclosure of "about 1 percent" inherently means .99 percent, which meets applicant's claim limitation of less than 1 percent.

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Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jenkins et al in view of WO 85/03194 ('134"). Jenkins et al is relied upon as discussed above. Jenkins et al does not disclose pipes.

'134 discloses HDPE compositions for forming pipes, see page 7, lines 18 and 24. Talc is present in an amount of from 1.0 to 6.0 phr, page 6, line 17. Pellets are disclosed, page 8, line 7.

The secondary reference demonstrates that it is known to form pipes out of the same composition as that of the primary reference. Thus it would have been obvious to one having ordinary skill in the art to form a pipe out of the composition of Jenkins et al. Extrusion is disclosed, abstract.

Pipes made by injection are well known in the art, and the Examiner takes official notice thereof.

Pipe couplings are prima-facie obvious over pipes, for two reasons. They are designed to work in the same system, and second a pipe may well be a pipe coupling, in that if it is used as an intermediate between two pipes, it has "coupled" the two pipes.

Response to Arguments

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11. Applicant's arguments filed 6-18-99 have been fully considered but they are not persuasive.

The examiners arguments concerning Jenkins set forth above are incorporated by reference here.

Applicant argues that there is no motivation to combine the references. Applicant states that this is because the HDPE in the WO patent '134 is used as a binder, ad the composition contains other elements. That the HDPE of WO '134 is used as a binder does not in any way destroy the motivation to combine. There is nothing in applicant's claim limitations sugtesting that the polyethylene composition is not used as a binder. It is of no relevance that the WO '134 patent discloses elastomers. Applicants claims are written so as to include all of these elements.

Applicants suggestin that the WO '134 disclosure at page 7, lines 15-30 that HDPE are stiff does not destroy motivation. This disclosure is only a statement of fact, lending support to the motivation to use the HDPE with talc. Further, on page 8 lines 1-10 WO '134 clearly states that the use of HDPE is advantageous.

12.

13. *Claim Rejections - 35 USC § 103*

14. Claims 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over GB 822,498,

'498. '498 discloses polyethylene compositions that have incorporated therein magnesium silicates, (which is talc, $3\text{MgO} \cdot 4\text{SiO}_2 \cdot \text{H}_2\text{O}$), see page 1, lines 82-83. The amount of talc overlaps applicants new claim 15 The purpose is to aid in extrusion. There is not disclosed applicant's claime HDPE. This may be because HDPE was not used in 1957. It would hage been obvious to


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one having ordinary skill in the art at the time the invention was made to use HDPE as the PE composition disclosed in '498 because the talc in the HDPE would obviously provide the same advantages as the talc in the PE.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles R. Nold whose telephone number is (703) 308-4416.


Charles R. Nold
Primary Examiner
Art Unit 1772

Because the enclosed documents are counterparts of non-English documents filed on July 14, 1998, and considered by the Examiner in February 1999, no additional fee is believed due. As all requirements of 37 CFR 1.97 ff, and all official guidelines pertaining to Information Disclosure Statements, have been complied with, it is respectfully requested that the Examiner consider the references and make them of record.

Respectfully submitted,



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JWS:nm

FEE Enclosed: \$None. Please charge any further fee to Dep.Acct. 19-3700.

DC2 #133530v1